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10/540,784	06/08/2005	Mark E. Fraley	21301P	9106

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EXAMINER	
MOORE, SUSANNA	

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1624	

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02/09/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

ADVISORY ACTION

The period for reply continues to run THREE MONTHS from the date of the final rejection. Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a) accompanied by the appropriate fee. The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. A reply within the meaning of 37 CFR 1.113 or a request for a continued examination (RCE) in compliance with 37 CFR 1.114 must be timely filed to avoid abandonment of this application.

The amendment filed 1/14/2009 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will be entered because: the proposed amendment is deemed to place the application in better form for appeal by materially simplifying the issues for appeal.

Claim Objections

Claims 40-42 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 112

The rejection of claims 37, 38 and 43 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement for the definition of the R^a and R^b substituents is **withdrawn** based on the amendments.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The rejection of claims 37-39 and 43 under 35 U.S.C. 103(a) as being unpatentable over Bilodeau et. al. (US 6380203 B1) is **withdrawn** based on the amendments.

The rejection of claims 37-39 and 43 under 35 U.S.C. 103(a) as being unpatentable over Bilodeau et. al. (US 6235741 B1) is **withdrawn** based on the amendments.

Claims 37, 38 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bilodeau et. al. (US 6245759 B1). The 12th specie listed in claim 2 of the reference, 1-(3-dimethylamino-propyl)-4-(3-thiophen-3-yl)pyrazolo(1,5-a)pyrimidin-6-yl-1H-pyridin-2-one is obvious over (3-thiophen-3-yl)pyrazolo(1,5-a)pyrimidin-6-yl-1H-pyridin-2-one. The only difference between the two named species is the substitution on the pyridyl ring at the 6-position of the bicycle, the 3-dimethylamino-propyl versus Applicant's hydrogen. The genus in column 27, line 32, teaches the two variables are alternatively useable. Thus, said claims are rendered obvious by the '759 patent.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the

application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Claims 37, 38 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeFeo-Jones et. al. (US 20020041880 A1).

The instant Application claims compounds of formula (I), wherein R^2, R^3 and R^5= hydrogen, R^4= 4-methoxyphenyl and R^1= alkyl and heterocyclyl substituted with a COOalkyl.

The reference teaches compounds of formula (I), wherein R^2, R^3 and R^5= hydrogen, R^4= 4-methoxyphenyl and R^1= thienyl. See page 46, example 1, bottom of left-hand column.

The only difference between the two named species is the substitution at R1, thienyl versus Applicant's alkyl and heterocyclyl substituted with a COOalkyl. The genus on page 6, left-hand column, paragraph 0056, 0060 and 0062. The genus in the reference teaches these variables are alternatively useable. This is just one example in the reference which renders the instant Application obvious. Thus, said claims are rendered obvious by DeFeo-Jones et. al.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of

invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

The above rejections all have common ownership. Applicant provided a statement in the remarks addressing the common ownership but this is not acceptable. The statement must be submitted as a declaration; thus must be submitted under 37 CFR 1.132 or 1.131 or 1.130, see the paragraph above. Thus, both 103 rejections above are maintained.

Double Patenting

The rejection of claims 37-39 and 43 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim1-3 of U.S. Patent No. 6235741 is **withdrawn** based on the terminal disclaimer submitted.

The rejection of claims 37-39 and 43 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim1-3 of U.S. Patent No. 6380203. is **withdrawn** based on the terminal disclaimer submitted.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUSANNA MOORE whose telephone number is (571)272-9046. The examiner can normally be reached on M-F 8:00-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Wilson can be reached on (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susanna Moore/
Examiner, Art Unit 1624

/Brenda L. Coleman/
Primary Examiner, Art Unit 1624